

Remarks

Applicants have amended claim 12. Support for the amendment can be found in original claims 15 and 17. Applicants have also amended claim 18 to bring it in line with the amendment to claim 12, from which it depends. No new matter has been introduced by the amendment. Claims 1-11, 13-17, and 19-23 have been canceled.

Claims 12 and 18 are pending and under examination. Reconsideration of this application, as amended, is respectfully requested in view of the following remarks.

Rejection under 35 U.S.C. § 102

The Examiner rejects claims 12, 17, and 18 for anticipation, relying on Davisson et al., Journal of Organ. Chem. 1986, 51, 4768-4779 (Davisson) and Kindon et al. WO 98/45309 (Kindon). Claim 17 has been cancelled. Independent claim 12 will be discussed first.

Claim 12, as amended, covers a salt of **monochloro-substituted** methylene bisphosphonic acid.

Davisson discloses **difluoro-substituted** methylene bisphosphonate. See page 4773.



Kindon teaches use of bisphosphonic acids of the formula of $\begin{array}{c} \text{O} \\ \parallel \\ \text{HO}-\text{P} \\ \mid \\ \text{HO} \end{array} \text{---} \text{Y} \text{---} \begin{array}{c} \text{O} \\ \parallel \\ \text{P}-\text{OH} \\ \mid \\ \text{OH} \end{array}$ as intermediates in synthesis of nucleotides. See page 9, line 15. In the above formula, Y is O, CF₂, CCl₂, or CBr₂. See page 9, line 17 and page 3, line 18. Among the bisphosphonic acids disclosed in Kindon, the compound closest to the claimed compound is **dichloro-substituted** methylene bisphosphonic acid. Accordingly, neither Davisson nor Kindon teaches a salt of **monochloro-substituted** methylene bisphosphonic acid, as required by claim 12. Thus, these two references do not anticipate claim 12. For at least the same reasons as set forth above, these two references also do not anticipate claim 18, which depends from claim 12.

Rejection under 35 U.S.C. § 103

The Examiner rejects claims 12, 17, and 18 for obviousness, relying on Kindon.

As mentioned above, claim 12 covers a salt of **monochloro-substituted** methylene bisphosphonic acid.

Kindon teaches use of **dichloro-substituted** methylene bisphosphonic acids as intermediates in synthesis of nucleotides. Nowhere Kindon teaches or suggests a **monochloro-substituted** methylene bisphosphonic acid, as required by claim 12. Without such a teaching or suggestion, claim 12 is not rendered obvious by Kindon. Neither is claim 18 rendered obvious, which depends from claim 12.

Double Patenting Rejection

The Examiner rejects claims 12, 17, and 18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over prior U.S. Patent 6,657,076.

Applicant would like to point out that the Examiner raised a double-patenting rejection relying on the same prior patent in the Office Action dated December 9, 2005. Applicants submitted a terminal disclaimer on June 8, 2006 to obviate the rejection. The terminal disclaimer was later approved by the U.S. Patent and Trademark Office (USPTO). Attached thereto as "Exhibit A" are copies of the terminal disclaimer previously filed and the approval of the terminal disclaimer downloaded from the USPTO website. Applicant therefore requests that the Examiner withdraw the double patenting rejection.

The fee in the total amount of \$120 for the Petition for Extension of Time fee is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply all charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 17325-246US2.

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Respectfully submitted,

Date: _____

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